

REMARKS

Claims 21 to 30 are pending.

It is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

Claim 21 was objected to based on formalities. Claim 21 has been rewritten as suggested by the Office Action. Accordingly, it is respectfully requested that the objection be withdrawn.

Claims 21 to 30 were rejected as indefinite under 35 U.S.C. § 112, second paragraph. While the rejections may not be agreed with, claims 21, 27 and 30 have been rewritten to better clarify the claimed subject matter. As to claims 21, 27 and 30, the present application specifically discloses that a "*scene that stays the same in parts is distinguished by the fact that parts of the scene are unchangeable in time.*" (Substitute Specification, page 10, lines 25 to 26). Accordingly, it is believed and respectfully submitted that claims 21, 27 and 30, and corresponding dependent claims 22 to 26, 28 and 29, are definite in view of the specification, since these claims would be understood by a person having ordinary skill in the art -- especially in view of the specification.

Approval and entry are respectfully requested, as is withdrawal of the indefiniteness rejections.

Claims 21, 22, 24, 26 to 28 and 30 were rejected under 35 U.S.C. § 102(e) as being anticipated by Bothe (U.S. Patent Application No. 2006/0187303).

To reject a claim under 35 U.S.C. § 102, the Office must demonstrate that each and every claim feature is identically described or contained in a single prior art reference. (*See Scripps Clinic & Research Foundation v. Genentech, Inc.*, 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991)). As explained herein, it is respectfully submitted that the Final Office Action does not meet this standard, for example, as to all of the features of the claims. Still further, not only must each of the claim features be identically described, an anticipatory reference must also enable a person having ordinary skill in the art to practice the claimed subject matter. (*See Akzo, N.V. v. U.S.I.T.C.*, 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986)).

As further regards the anticipation rejections, to the extent that the Final Office Action may be relying on the inherency doctrine, it is respectfully submitted that to rely on inherency, the Office must provide a "basis in fact and/or technical reasoning to reasonably

support the determination that the allegedly inherent characteristics *necessarily* flows from the teachings of the applied art.” (See M.P.E.P. § 2112; emphasis in original; and see *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Int’f. 1990)). Thus, the M.P.E.P. and the case law make clear that simply because a certain result or characteristic may occur in the prior art does not establish the inherency of that result or characteristic.

The “Bothe” reference is a U.S. national phase application of PCT Application No. PCT/DE03/02507, which was *not* published in English. The present application is a U.S. national phase application of PCT Application No. PCT/DE04/00305, which claims priority from German Patent Application No. 103 18 500.3, filed on April 24, 2003. A certified English translation of German Patent Application No. 103 18 500.3 is submitted herewith. Thus, the PCT filing date of the “Bothe” reference (which is July 25, 2003) is after the effective April 24, 2003 filing date of the present application.

Accordingly, it is respectfully submitted that the “Bothe” reference is not prior art as to the present application, and withdrawal of the anticipation rejections is therefore respectfully requested.

Claims 23, 25 and 29 were rejected under 35 U.S.C. § 103(a) as unpatentable over the “Bothe” reference.

To reject a claim under 35 U.S.C. § 103(a), the Office bears the initial burden of presenting a *prima facie* case of obviousness. *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish *prima facie* obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

Also, as clearly indicated by the Supreme Court in *KSR*, it is “important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements” in the manner claimed. See *KSR Int’l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727 (2007). In this regard, the Supreme Court further noted that “rejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *Id.*, at 1396. Second, there must be a reasonable expectation of success. *In re*

*Merck & Co., Inc.*, 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim features. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

As explained above, the "Bothe" reference is not prior art as to the present application. Accordingly, withdrawal of the obviousness rejections is therefore respectfully requested since the "Bothe" reference is not prior art.

**Conclusion**

In view of the foregoing, Applicants respectfully submit that all pending claims are allowable. It is therefore respectfully requested that the rejections and objections be withdrawn. Prompt reconsideration and allowance of the present application are therefore respectfully requested.

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Respectfully submitted,

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